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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/296,276	04/22/1999	ROLF SCHUMACHER	225/47721	8165

7590

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CROWELL & MORING LLP  
INTELLECTUAL PROPERTY GROUP  
P.O. BOX 14300  
WASHINGTON, DC 20044-4300

EXAMINER

LEE, EDMUND H

ART UNIT

PAPER NUMBER

1732

DATE MAILED: 08/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/296,276

Applicant(s)

SCHUMACHER, ROLF

Examiner

EDMUND H. LEE

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 28-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 28-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 35 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sugibayashi (JP 57116623 A) in view of Kato et al (USPN 5225264). In regard to independent claim 36, Sugibayashi teach the basic claimed process including manufacturing a covering or trim part with directly molded-on carrier (figs 1-6); placing a thin sheet/decorative part into an at least two-part injection mold (figs 1-6); closing the mold, thereby moving a cutting edge provided on a first part of the mold past an inside wall area of a second part of the mold and thereby cutting the thin sheet to a precise shape by shearing off an outer edge of the thin sheet, while simultaneously pushing the thin sheet in front of the cutting edge to an interior bottom surface of the second part of the mold, providing sealing between the cutting edge and a front edge of the decorative part formed by shearing off the outer edge, and defining at least part of a mold cavity between the first part of the mold and the thin sheet (figs 1-6)--as a note, it should be noted that fig 4 clearly shows at least part of a mold cavity between the first part of the mold and the thin sheet; injecting an injection molding compound into the mold cavity after cutting the thin sheet, which upon curing permanently bonds to the thin sheet (figs

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1-6); opening the mold and removing the covering or trim part and mold-on carrier from the mold (figs 1-6)--as a note, such is inherent with the process in order to produce a product useable by consumers. However, Sugibayashi does not teach using a veneer wood layer or sheet metal part as the thin sheet. Kato et al teach injection molding a covering or trim part having a decor part comprised of wood veneer glued to a metal sheet which is glued to another wood veneer (blind veneer) (figs 1-9). Sugibayashi and Kato et al are combinable because they are analogous with respect to molding a decorative part. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute a sheet of the decor part of Kato et al for the decor part of Sugibayashi in order to form an aesthetically different product. In regard to claim 35, Sugibayashi does not teach embedding fastening elements for the covering or trim part in the injection molding compound. Molded containers with fasteners embedded therein are well-known in the molding art in order to reduce production steps. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to embed a fastening element in the injection molding compound of Sugibayashi in order to securely fasten a fastening element in the article of Sugibayashi and to eliminate the need for a subsequent step of attaching a fastening element to the article of Sugibayashi.

3. Claims 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sugibayashi (JP 57116623 A) in view of Kato et al (USPN 5225264) as applied to claim 36 above. The above teachings of Sugibayashi in view of Kato et al are incorporated hereinafter. Sugibayashi does not teach the specific injection molding temperature and

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the specific mold temperature. In regard to the specific injection molding temperature, molding temperature is well-known in the molding art as an important molding parameter that is dependent on the molding material, preform material, and equipment. Further, the desired temperature would have been obviously and readily determined through routine experimentation by one having ordinary skill in the art at the time the invention was made. Furthermore, the claimed temperature is generally well-known in the molding art and it would have been obvious to one of ordinary skill in the art at the time the invention was made to injection mold at the claimed temperature in order to effectively connect the decor part to the molding compound. In regard to the specific mold temperature, mold temperature is well-known in the molding art as important molding parameters and the desired temperature would have been obviously and readily determined through routine experimentation by one having ordinary skill in the art at the time the invention was made. Further, the claimed temperature is generally well-known in the molding art and it would have been obvious to one of ordinary skill in the art at the time the invention was made to set the temperature of the mold of Sugibayashi at the claimed temperature in order to effectively mold a high quality injection molded covering or trim part.

4. Claims 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sugibayashi (JP 57116623 A) in view of Kato et al (USPN 5225264) as applied to claim 36 above. The above teachings of Sugibayashi in view Kato et al are incorporated hereinafter. Sugibayashi does not teach placing a nonwoven coating saturated with phenol melamine resin and a layer of glue on the veneer wood layer; placing a layer of

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glue on the veneer wood layer; and placing a layer of blind veneer on the veneer wood layer. Kato et al teach injection molding a covering or trim part having a decor part comprised of wood veneer glued to a metal sheet which glued to another wood veneer (blind veneer) (figs 1-9). Sugibayashi and Kato et al are combinable because they are analogous with respect to molding a decorative part. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute a sheet of the decor part of Kato et al for the thin sheet of Sugibayashi in order to form a product having a wood veneer appearance. In regard to placing a nonwoven coating saturated with phenol melamine resin on the veneer wood layer, such is well-known in the molding art as a substitutable alternative for a metal layer. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the claimed nonwoven coating for the metal layer of Sugibayashi (modified) in order to reduce cost and further diversify the covering or trim part of Sugibayashi.

5. Claims 33-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sugibayashi (JP 57116623 A) in view of Kato et al (USPN 5225264) as applied to claim 36 above and further in view of Conner (USPN 4369157). The above teachings of Sugibayashi and Kato et al are incorporated hereinafter. Sugibayashi does not teach using a decor part comprised of a sheet metal part; applying a coupling layer to the backside of the sheet metal part; and heating or activating the coupling layer with the injection molding compound. Conner teaches injection molding a covering having a decor part comprised of a sheet metal part with a coupling layer (adhesive layer) attached to a backside thereof; heating or activating the coupling layer with the injection

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molding material (col 5, Ins 38-41; col 10, Ins 1-35); using a reactive hot melt type adhesive or dry glue film (col 10, Ins 1-35). Sugibayashi and Conner are combinable because they are analogous with respect to injection molding against a sheet preform to create a decorative article. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the decor part of Conner for the thin sheet of Sugibayashi in order to further diversify the covering or trim part of Sugibayashi.

6. Applicant's arguments filed 6/15/04 have been fully considered but they are not persuasive. Applicant argues that the combination of JP 57-116623 and Kato et al does not teach providing sealing between the cutting edge and a front edge of the decorative part formed by shearing off the outer edge. Applicant is directed to fig 4 of JP 57-116623 that shows a seal formed between the cutting edge of mold part 8 and a front edge of decorative part 2. The seal is formed by shearing off the outer edge of the decorative part.

In regard to applicant's arguments concerning the obviousness of claims 33-34, applicant is reminded that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Here, the closing of the mold is taught by the combined teachings of JP 57-116623 and Kato et al. Connor was not provided to teach the step of closing the mold but instead to teach using a decor part comprised of a

sheet metal part; applying a coupling layer to the backside of the sheet metal part; and heating or activating the coupling layer with the injection molding compound.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDMUND H. LEE whose telephone number is 571.272.1204. The examiner can normally be reached on **MONDAY-THURSDAY FROM 9AM-4PM**.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianni can be reached on 571.272.1196. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

EHL

EDMUND H. LEE  
Primary Examiner  
Art Unit 1732



8/26/04